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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,931	11/30/2000	Rick W. Staub	34411.7USD1	6409

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09/24/2002

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EXAMINER

MYERS, CARLA J

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/727,931

Applicant(s)

STAUB ET AL.

Examiner

Carla Myers

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.                      6) ☐ Other: \_\_\_\_\_

Art Unit: 1634

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed, i.e. a sample collection device for identifying newborn/mother pairs.

2. The disclosure is objected to because of the following informalities: .

The first page of the specification should be amended to clarify the relationship between the present application and parent application. The statement that the present application claims priority to application 09/189,156 does not clarify whether the present application is a continuation, continuation-in-part or division of application 09/189,156. Accordingly, the specification should be amended to indicate that the present application is a divisional of application 09/189,156.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Burgoyne (U.S. Patent No. 5,496,562).

Burgoyne teaches a dry solid medium for collection of genetic material suitable for storage and subsequent analysis (column 3). The genetic material may be a sample of blood or any other biological material (column 2). The dried solid medium containing the genetic

Art Unit: 1634

material is stored in a container (column 5). The dry solid medium may be in the form of a card and the card may be marked in a regular pattern and labeled so as to assist in the systematic storage and retrieval of the cards (column 5). Accordingly, Burgoyne teaches a sample collection container comprising a location and a label, having the property that it could be used to store a maternal cell sample and a location and label, having the property that it could be used to store a newborn cell sample. Additional locations and labels may also be present to allow for the storage of other samples.

4. Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hochmeister (Arch Kriminol (Sept/October 1997) 200: 113-120 (includes translation)).

Hochmeister teaches that successfully carrying out DNA analysis of biological evidence requires that the samples to be used for DNA analysis be correctly collected, identified, packaged, sealed and stored. Hochmeister discloses a foldable cardboard box for drying and storage by means of cotton swabs containing collected biological evidence. The samples may be saturated with blood or may be buccal smear swabs. Hochmeister (see abstract) states that "In this box the evidence is properly packed, labelled and sealed, thus preventing cross contamination, degradation and sample switch). It is stated that the disclosed sample storage method provides for the possibility of unmistakable and immediate identification of the collected evidence by labeling or inscription and sealing of the sample to ensure uninterrupted chain of custody and prevents tampering of the biological sample. Accordingly, Hochmeister teaches a sample collection container comprising a location and a label, having the property that it could be

Application/Control Number: 09/727,931

Page 4

Art Unit: 1634

used to store a maternal cell sample and a location and label, having the property that it could be used to store a newborn cell sample.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carla Myers whose telephone number is (703) 308-2199. The examiner can normally be reached on Monday-Thursday from 6:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703)-308-1152. The fax number for the Technology Center is (703)-305-3014 or (703)-305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Carla Myers

September 17, 2002

*Carla Myers*  
CARLA J. MYERS  
PRIMARY EXAMINER